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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,294	11/29/2000	Masashi Koshino	11P338920	8772

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EXAMINER

LELE, TANMAY S

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 06/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,294

Applicant(s)

KOSHINO, MASASHI

Examiner

Tanmay S Lele

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6 and 13 – 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 6 and 13 – 18, it was not understood how, “wherein the setting means sets a high speed travel mode representing arrived call reception prohibition when the broadcast data from the plurality of base stations and the reception levels of these data undergo frequent changes,” as independent claim relates to “automatic function setting” based on signals received from base stations. Further it was not understood what was meant by, “call reception prohibition when the broadcast data from the plurality of base stations and the reception levels of these data undergo frequent changes,” as this could be interpreted as a user not receiving any calls while in motion (ie a car or train), thus rendering the phone useless. For purposes of examination, it was assumed the user could manually set the device to a predefined state (such as default).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Jokimies et al. (Jokimies, US Patent No. 6,526,267).

Regarding claims 1 and 7, Jokimies teaches of a radio communication terminal system and method which executes a waiting operation by receiving broadcast data from a plurality of base stations (Figures 1, 3, and 4 and starting column 1, line 33 and ending column 2, line 4), comprising a storing means for storing broadcast data received from a plurality of base stations when the system is in a preset presence position and reception levels of these broadcast data as registered data (Figure 3 and column 4, lines 38 – 46 and column 3, lines 4 – 24), and comparing means for comparing (Figures 2 and 3 and starting column 3, lines 26 – 44), in the waiting operation, the broadcast data received from the plurality of base stations and the reception levels of these data with registered data in the storing means (as seen in Figures 3 and 4 and column 4, lines 46 – 54 and column 3, lines 4 – 24).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 – 6 and 8 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Jokimies, US Patent No. 6,526,267) in view of Kraft et al. (Kraft, US Patent 6,463,278).

Regarding claims 2 and 8, Jokimies teaches of a radio communication terminal system

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and method which executes a waiting operation by receiving broadcast data from a plurality of base stations (Figures 1, 3, and 4 and starting column 1, line 33 and ending column 2, line 4), comprising a storing means for storing broadcast data received from a plurality of base stations when the system is in a preset presence position and reception levels of these broadcast data as registered data (Figure 3 and column 4, lines 38 – 46 and column 3, lines 4 – 24), and comparing means for comparing (Figures 2 and 3 and starting column 3, lines 26 – 44), in the waiting operation, the broadcast data received from the plurality of base stations and the reception levels of these data with registered data in the storing means (as seen in Figures 3 and 4 and column 4, lines 46 – 54 and column 3, lines 4 – 24).

Jokimies does not specifically teach of setting means for setting, when the comparing means detects coincidence of compared data, its functions of contents of preset function setting items corresponding to the pertinent registered data.

In a related art dealing with automatic telephone parameter selection, Kraft teaches of setting means for setting, when the comparing means detects coincidence of compared data, its functions of contents of preset function setting items corresponding to the pertinent registered data (column 1, lines 35 – 54 and Tables 1 –3).

It would have been obvious to one skilled in the art at the time of invention to have included into Jokimies' detection system, Kraft's automatic present function provisions, for the purposes of automatically setting user preferences in accordance with different environments (ie meetings, car use, ect.), as taught by Kraft.

Regarding claims 3 and 9, Jokimies teaches of a radio communication terminal system and method which executes a waiting operation by receiving broadcast data from a plurality of

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base stations (Figures 1, 3, and 4 and starting column 1, line 33 and ending column 2, line 4), comprising a storing means for storing broadcast data received from a plurality of base stations when the system is in a preset presence position and reception levels of these broadcast data as registered data (Figure 3 and column 4, lines 38 – 46 and column 3, lines 4 – 24), and comparing means for comparing (Figures 2 and 3 and starting column 3, lines 26 – 44), in the waiting operation, the broadcast data received from the plurality of base stations and the reception levels of these data with registered data in the storing means (as seen in Figures 3 and 4 and column 4, lines 46 – 54 and column 3, lines 4 – 24).

Jokimies does not specifically teach of setting means for setting, when the comparing means detects coincidence of compared data, its functions of contents of preset function setting items corresponding to the pertinent registered data, the preset function setting items at least including call arrival tone, call arrival tone level, out-of-home dealing function ON/OFF and call transfer function ON/OFF.

In a related art dealing with automatic telephone parameter selection, Kraft teaches of setting means for setting, when the comparing means detects coincidence of compared data, its functions of contents of preset function setting items corresponding to the pertinent registered data (column 1, lines 35 – 54 and Tables 1 –3) the preset function setting items at least including call arrival tone, call arrival tone level, out-of-home dealing function ON/OFF and call transfer function ON/OFF (column 1, lines 35 – 54 and column 2, lines 57 – 68 and Tables 1 –3)

It would have been obvious to one skilled in the art at the time of invention to have included into Jokimies' detection system, Kraft's automatic present function provisions, for the

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purposes of automatically setting user preferences in accordance with different environments (ie meetings, car use, ect.), as taught by Kraft.

Regarding claims 4 and 10, Jokimies teaches of a radio communication terminal system and method which executes a waiting operation by receiving broadcast data from a plurality of base stations (Figures 1, 3, and 4 and starting column 1, line 33 and ending column 2, line 4), comprising a storing means for storing broadcast data received from a plurality of base stations when the system is in a preset presence position and reception levels of these broadcast data as registered data (Figure 3 and column 4, lines 38 – 46 and column 3, lines 4 – 24), and comparing means for comparing (Figures 2 and 3 and starting column 3, lines 26 – 44), in the waiting operation, the broadcast data received from the plurality of base stations and the reception levels of these data with registered data in the storing means (as seen in Figures 3 and 4 and column 4, lines 46 – 54 and column 3, lines 4 – 24).

Jokimies does not specifically teach of setting means for setting, when the comparing means detects coincidence of compared data, its functions of contents of preset function setting items corresponding to the pertinent registered data and restoring a preset default setting [when the broadcast data received from the plurality of base stations and the reception levels of these data] are changed from the compared registered data (note brackets are added for clarity; these limitations are met from the above cited passages).

In a related art dealing with automatic telephone parameter selection, Kraft teaches of setting means for setting, when the comparing means detects coincidence of compared data, its functions of contents of preset function setting items corresponding to the pertinent registered data (column 1, lines 35 – 54 and Tables 1 –3) and restoring a preset default setting when the

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broadcast data received from the plurality of base stations and the reception levels of these data are changed from the compared registered data (column 1, lines 35 – 54 and Tables 1 –3 and column 4, lines 46 – 57).

It would have been obvious to one skilled in the art at the time of invention to have included into Jokimies' detection system, Kraft's automatic present function provisions, for the purposes of automatically setting user preferences in accordance with different environments (ie meetings, car use, ect.), as taught by Kraft.

Regarding claims 5 and 11, Jokimies teaches of a radio communication terminal system and method which executes a waiting operation by receiving broadcast data from a plurality of base stations (Figures 1, 3, and 4 and starting column 1, line 33 and ending column 2, line 4), comprising a storing means for storing broadcast data received from a plurality of base stations when the system is in a preset presence position and reception levels of these broadcast data as registered data (Figure 3 and column 4, lines 38 – 46 and column 3, lines 4 – 24), and comparing means for comparing (Figures 2 and 3 and starting column 3, lines 26 – 44), in the waiting operation, the broadcast data received from the plurality of base stations and the reception levels of these data with registered data in the storing means (as seen in Figures 3 and 4 and column 4, lines 46 – 54 and column 3, lines 4 – 24).

Jokimies does not specifically teach of setting means for setting, when the comparing means detects coincidence of compared data, its functions of contents of preset function setting items corresponding to the pertinent registered data, the preset function setting items at least including call arrival tone, call arrival tone level, out-of-home dealing function ON/OFF and call transfer function ON/OFF and restoring a preset default setting [when the broadcast data

received from the plurality of base stations and the reception levels of these data] are changed from the compared registered data (note brackets are added for clarity; these limitations are met from the above cited passages).

In a related art dealing with automatic telephone parameter selection, Kraft teaches of setting means for setting, when the comparing means detects coincidence of compared data, its functions of contents of preset function setting items corresponding to the pertinent registered data (column 1, lines 35 – 54 and Tables 1 –3) the preset function setting items at least including call arrival tone, call arrival tone level, out-of-home dealing function ON/OFF and call transfer function ON/OFF (column 1, lines 35 – 54 and column 2, lines 57 – 68 and Tables 1 –3) and restoring a preset default setting when the broadcast data received from the plurality of base stations and the reception levels of these data are changed from the compared registered data (column 1, lines 35 – 54 and Tables 1 –3 and column 4, lines 46 – 57).

It would have been obvious to one skilled in the art at the time of invention to have included into Jokimies' detection system, Kraft's automatic present function provisions, for the purposes of automatically setting user preferences in accordance with different environments (ie meetings, car use, ect.), as taught by Kraft.

Regarding claims 6, 13, 14, 15, 12, 16, 17, and 18, Jokimies in view of Kraft, teach all the claimed limitations as recited in claims 2 – 5 and 8 – 11, respectively. Kraft further teaches of wherein the setting means sets a high speed travel mode representing arrived call reception prohibition when the broadcast data from the plurality of base stations and the reception levels of these data undergo frequent changes (column 4, lines 49 – 58, column 6, lines 24 – 31).


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Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanmay S Lele whose telephone number is (703) 305-3462. The examiner can normally be reached on 9 - 6:30 PM Monday – Thursdays and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Nay A. Maung can be reached on (703) 308-7745. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.


Tanmay S Lele
Examiner
Art Unit 2681

tsl
May 30, 2003


NAY MAUNG
PRIMARY EXAMINER